

REMARKS

This Application has been carefully reviewed in light of the Office Action. Applicants appreciate the Examiner's consideration of the Application. In order to advance prosecution of this Application, Applicants have responded to each notation by the Examiner. Applicants respectfully request reconsideration and favorable action in this case.

Specification Objections

The Examiner objects to the amendments made to the Specification in Applicants' Response filed October 13, 2008, stating that the amendments introduce new matter into the disclosure. Applicants respectfully traverse this objection.

Applicants respectfully point out that the Applicant's Specification was amended to include subject matter of U.S. Patent No. 6,052,681 to Harvey ("*Harvey*"), which was already incorporated by reference in the Applicants' Specification. As such, the amendments to the Applicants' Specification do not introduce new matter.

In particular, according to the Applicants' Specification:

In order to help illustrate an embodiment of the present application, reference is made to the disclosure of PCT/AU95/00560 (*US serial number 08/793,575 filed May 22, 1997*), both of which are herein *incorporated by reference*.

(Applicants' Specification, Page 6, Lines 27-30 (emphasis added).) That is, the Applicants' Specification incorporates by reference US Patent Application Serial No. 08/793,575—which is now patented as *Harvey*.

Furthermore, according to the M.P.E.P., "[t]he information incorporated [in an application] is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference with the actual text *is not new matter*." (M.P.E.P. 2163.07(b) (emphasis added). Accordingly, none of the subject matter of *Harvey* is new matter.

Additionally, Applicants respectfully note that the Applicants' Specification was amended to include subject matter of the passages of *Harvey* at Col. 13, Line 17 – Col. 14, Line 12 and Col. 24, Line 60 – Col. 25, Line 13. For the convenience of the Examiner, Applicants have included a copy of *Harvey* at Exhibit A.

Applicants respectfully submit that the amendments made to the Applicants' Specification *are not new matter*. Furthermore, *the M.P.E.P. provides support for the Applicants' position*, as is discussed above. For at least this reason, Applicants respectfully request that the objections to the Applicants' Specification be withdrawn.

Claim Objections

The Examiner objects to Claims 1-5, stating that none of the claims are directed to statutory subject matter. Applicants respectfully submit that these objections are improper. In particular, the M.P.E.P. clearly provides that an objection is appropriate when "the form of the claim (*as distinguished from its substance*) is improper." M.P.E.P. 706.01 (emphasis added). Statutory subject matter clearly goes to the substance of a claim, so the objections to Claims 1-5 are improper. Accordingly, Applicants respectfully request reconsideration and favorable action.

Claim Amendments and Cancellations

Applicants respectfully note that the Examiner continues to reject Claims 1, 11, and 17-22 regarding the limitation "an initial information entry identifier." In particular, the Examiner relies on 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 112, second paragraph, in making these rejections. (Office Action, Pages 4-5.) Applicants respectfully traverse these rejections.

Applicants respectfully note that *none of the rejections are relevant anymore*. In particular, Claims 17-22 were *previously cancelled*. Furthermore, both Claims 1 and 11 were *previously amended to remove the limitation* "an initial information entry identifier."

For at least these reasons, Applicants respectfully request that these rejections of Claims 1, 11, and 17-22 be withdrawn.

Claim Rejections Regarding the Written Description Requirement

The Examiner rejects Claims 11-12, 16, 18, 20, and 22 under 35 U.S.C. § 112, first paragraph, stating that the claims fail to comply with the written description requirement. In particular, the Examiner points to "computer-readable medium" as not being supported by the Applicants' Specification or drawings. Applicants respectfully traverse these rejections.

First, Applicants respectfully note that “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” (M.P.E.P. § 2163.02.) Thus, the Applicants’ Specification does not have to actually say “computer-readable medium” in order for the description requirement to be met.

Second, Claim 5, as originally filed, clearly states “wherein the instructions are implemented via a directory system such as X.500 or LDAP.” (Applicants’ Specification, Claim 5.) The disclosure of X.500 and LDAP, at the very least, inherently discloses a “computer-readable medium,” as would be understood by one of ordinary skill in the art.

For at least these reasons, Claims 11-12, 16, 18, 20, and 22 are allowable under 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 11-12, 16, 18, 20, and 22.

Claim Rejections Regarding Specific and Substantial Utility

The Examiner rejects Claims 1 and 11 under 35 U.S.C. § 112, first paragraph, stating that the claims are not supported by a specific and substantial utility. Applicants respectfully traverse these rejections.

First, Applicants respectfully point out that the Examiner fails to provide a *prima facie* showing of no specific and substantial utility. According to the M.P.E.P.:

(1) Where the asserted utility is not specific or substantial, a *prima facie* showing must establish that it is more likely than not that a person of ordinary skill in the art would not consider that any utility asserted by the applicant would be specific and substantial. ***The prima facie showing must contain the following elements:***

(i) An explanation that clearly sets forth the reasoning used in concluding that the asserted utility for the claimed invention is not both specific and substantial nor well-established;

(ii) Support ***for factual findings*** relied upon in reaching this conclusion; ***and***

(iii) ***An evaluation of all relevant evidence of record, including utilities taught in the closest prior art.***

(M.P.E.P. § 2107(II)(C)(1) (emphasis added).) That is, in order to provide a *prima facie* showing of no specific and substantial utility, the Examiner ***must*** provide, at least, “[s]upport for factual findings” and “[a]n evaluation of all relevant evidence of record, including utilities taught in the closest prior art.”

Contrary to this, Applicants respectfully note that the Examiner fails to meet either of these requirements. For example, the Examiner provides *absolutely no support* for its statement that “the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.” (Office Action, Page 4.) In fact, all the Examiner states is that “one skilled in the art clearly would not know how to use the claimed invention.” (Office Action, Page 4.) Not only does this statement *fail to meet the requirements imposed on the Examiner*, but the statement is clearly incorrect—especially in light of the Applicants’ Specification at, for example, at least Page 5, Line 7 – Page 6, Line 3, and further in light of *Harvey*—which is a part of the Applicants’ Specification in light of the incorporation by reference and M.P.E.P. 2163.07(b)—at, for example, at least Col. 13, Line 17 – Col. 14, Line 18, and Col. 24, Line 60 – Col. 25, Line 13.

Second, Applicants respectfully point out that Claims 1 and 11 include a “specific and substantial utility.” In particular, according to the M.P.E.P., an invention has a specific utility when “an applicant has disclosed a specific use for or application of the invention,” as opposed to when “the applicant merely indicates that the invention may prove useful without identifying with specificity why it is considered useful.” (M.P.E.P. § 2107.01(I)(A).) Applicants respectfully note that “improving the operational performance of a database (or database system)” (Applicants’ Specification, Page 5, Lines 7-8) is a specific use for the invention. As a result, the claimed invention satisfies the “specific utility” requirement.

With regard to the substantial utility requirement, the M.P.E.P. states “to satisfy the ‘substantial’ utility requirement, an asserted use must show that the claimed invention has a significant and presently available benefit to the public.” (M.P.E.P. § 2107.01(I)(B) (citing *Fisher*, 421 F.3d 1365, 1371 (Fed Cir. 2005).) Clearly, “improving the operational performance of a database (or database system)” has a significant and presently available benefit to the public. Accordingly, the claimed invention satisfies the “substantial utility” requirement.

For at least these reasons, Claims 1 and 11 are allowable under 35 U.S.C. § 101. Reconsideration and favorable action are requested.

Claim Rejections Regarding Enablement

The Examiner rejects Claims 1 and 11 under 35 U.S.C. § 112, first paragraph, contending that the claims are not enabled. Applicants respectfully traverse these rejections.

“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with the information known in the art without undue experimentation.” (M.P.E.P. § 2164.01 (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988)).) Applicants respectfully submit that this test is met by the Applicants’ Specification at, for example, at least Page 5, Line 7 – Page 6, Line 3, and further by *Harvey*—which is a part of the Applicants’ Specification in light of the incorporation by reference and M.P.E.P. 2163.07(b) —at, for example, at least Col. 13, Line 17 – Col. 14, Line 18, and Col. 24, Line 60 – Col. 25, Line 13. In order to further assist the Examiner in determining that the test of enablement is met, Applicants have included a copy of *Harvey* at Exhibit A.

For at least these reasons, Claims 1 and 11 are allowable under 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 1 and 11.

Rejections of Claims 1-5, 15, 23, and 25 Under Section 101

The Office Action rejects Claims 1-5, 15, 23, and 25 under 35 U.S.C. § 101, stating that the claims are not directed to statutory subject matter. Applicants respectfully traverse these rejections. In order to advance prosecution, however, Claim 1 had been amended to include “determining, *using a processor*, whether an instruction or operation adds an information entry to or removes the information entry from a database system” and “amending, in accordance with the instruction or operation, the database system, *using the processor*, by adding the information entry to or removing the information entry from the database system.” (emphasis added). Support for this amendment may be found in the Applicants’ Specification at, for example, at least Claim 11. In particular, Claim 11, as originally filed, clearly states “means for processing an instruction or operation by determining whether the instruction or operation adds information or removes information from the database.” (Applicants’ Specification, Claim 11 (emphasis added).) The disclosure of a “means for processing” combined with a “database,” at the very least, inherently discloses a “processor,” as would be understood by one of ordinary skill in the art.

Since Claim 1 includes a processor, Claim 1 is “tied to another statutory category (such as a particular apparatus)”—*the processor*. Thus, under the May 15, 2008 memorandum provided by John J. Love, Deputy Commissioner for Patent Examining Policy

(which the Office Action points to as the current policy in force at the USPTO), Claim 1 is allowable under 35 U.S.C. § 101.

For at least this reason, Claim 1 and its respective dependent claims are allowable under 35 U.S.C. § 101. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 1-5, 15, 23, and 25.

Rejections of Claims 11-12, 16, 24, and 26 Under Section 101

The Examiner rejects Claims 11-12, 16, 24, and 26 under 35 U.S.C. § 101, stating that the claims are not directed to statutory subject matter. Applicants respectfully traverse these rejections.

Claim 11 includes a “computer-readable medium” and “means, encoded in the computer-readable medium.” According to the M.P.E.P., “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, *and is thus statutory.*” (M.P.E.P. 2106.01(I) (emphasis added).) As a result, the Examiner’s continued rejection of Claim 11 is *contrary to the M.P.E.P.*

Furthermore, Applicants note that in rejecting Claim 11 the Examiner relies on the statement of the M.P.E.P. that “a claim that recites a computer that solely calculates a mathematical formula (see Benson) or a computer disk that solely stores a mathematical formula is not directed to the type of subject matter eligible for patent protection.” (M.P.E.P. 2106(IV)(C)(3); *see also* Office Action, Page 6.) This statement of the M.P.E.P., however, is not applicable to Claim 11.

In particular, the statement relied upon by the Examiner deals exclusively with preemption of a 35 U.S.C. § 101 judicial exception. Applicants, however, respectfully point out that the Examiner has not met the requirements of showing such a preemption:

If USPTO personnel determine that the claimed invention preempts a 35 U.S.C. 101 judicial exception, they *must identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers every substantial practical application thereof.*

(M.P.E.P. 2106(IV)(C)(3).) In this case, the Examiner has not provided an identification of “the abstraction, law of nature, or natural phenomenon,” and the Examiner has also not

provided an explanation of “why the claim covers every substantial practical application thereof.” As such, the Examiner’s rejections are adverse to the M.P.E.P., and should be withdrawn.

For at least these reasons, Claim 11 at its dependent claims are allowable under 35 U.S.C. § 101. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 11-12, 16, 24, and 26.

Rejections Under Section 103

The Examiner rejects Claims 1-5, 11-12, 15-16, and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2002/0038228 filed by Waldorf et al. (“*Waldorf*”) in view of U.S. Patent No. 6,892,185 to Van Etten et al. (“*Van Etten*”). Applicants respectfully traverse these rejections for at least the reasons discussed below.

Applicants respectfully submit that the combination of *Waldorf* and *Van Etten* proposed by the Examiner fails to disclose, teach, or suggest elements specifically recited in Applicants’ claims. For example, the *Waldorf-Van Etten* combination proposed by the Examiner fails to disclose, teach, or suggest the following recited in Independent Claim 1:

adding the information entry comprises first adding the information entry to an ‘out’ table in the database system; and
removing the information entry comprises first removing the information entry from an ‘in’ table in the database system.

The Examiner relies on the passage at Paras. 0063-0064 to teach these elements. (Office Action, Page 8.) However, although this passage of *Waldorf* discloses adding and removing records from an “Out Table 302” and an “In Table 304” of *Waldorf* the passage ***fails to disclose any type of order of such an addition or removal***. As such, the passage fails to disclose “adding the information entry comprises ***first adding the information entry to an ‘out’ table*** in the database system; and removing the information entry comprises ***first removing the information entry from an ‘in’ table*** in the database system” of independent Claim 1 (emphasis added).

Moreover, other passages of *Waldorf* clearly state that a record is first generated in an “***In Table 304***” of *Waldorf*, and an instruction is first removed from an “***Out Table 302***” of *Waldorf*. For example, according to the passage at Para. 0065 of *Waldorf*:

FIG. 4 is a flowchart 400 illustrating an exemplary overview method of monitoring an instance of a process. ***In State 410, an instance of the process***

begins. One system includes a module instigating an instance of a process. In another system, an external application ***generates a record in the In Table 304*** and initiates the instance of the process.

(emphasis added). That is, the passage clearly states that, ***at the very beginning*** of the method of Fig. 4, a record is ***generated in the “In Table 304”*** of *Waldorf*—***not in an “out’ table,”*** as is recited in independent Claim 1. Furthermore, according to the passage at Para. 0071 of *Waldorf*:

For example, upon receiving an instruction from the Out Table 302, the application can acknowledge receipt of the instruction by providing an indication in the Status field 334. The monitoring system can then ***remove the instruction from the Out Table 302.***

(emphasis added). That is, prior to disclosing any other type of removal in the method of Fig. 4 of *Waldorf*, the passage clearly states that an instruction is ***removed from the “Out Table 302”*** of *Waldorf*—***not an “in’ table,”*** as is recited in independent Claim 1.

As a result, *Waldorf* fails to disclose, teach, or suggest “adding the information entry comprises ***first adding the information entry to an ‘out’ table*** in the database system; and removing the information entry comprises ***first removing the information entry from an ‘in’ table*** in the database system” of independent Claim 1 (emphasis added). Thus, the *Waldorf-Van Etten* combination proposed by the Examiner fails to disclose, teach, or suggest the elements of Claim 1. For at least these reasons, independent Claim 1 and its respective dependent claims are allowable under 35 U.S.C. § 103. For analogous reasons, independent Claim 11 and its respective dependent claims are allowable under 35 U.S.C. § 103. Accordingly, Applicants respectfully request reconsideration and allowance of Claims 1-5, 11-12, 15-16, and 23-26.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Keiko Ichiye, the Attorney for Applicants, at the Examiner's convenience at (214) 953-6494.

Although Applicants believe no fee is due, the Commissioner is authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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